

## **REMARKS**

Claims 1-22 are pending in the Application and all have been rejected in the Office action mailed July 23, 2007. No claims are amended by this response. Claims 1, 16, and 22 are independent claims. Claims 2-15 and 17-21 depend from independent claims 1 and 16, respectively.

The Applicant respectfully requests reconsideration of pending claims 1-22, in light of the following remarks.

### **Rejections of Claims**

The Applicant notes that every claim rejection is based on obviousness. Many claims, such as claims 1-12, stand rejected as being obvious in view of **two** references, while some claims, such as claims 13-22, stand rejected as being obvious in view of **three** references. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is **not** whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP at § 2141.02. The law is well settled that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather "some teaching or suggestion in the references to support their use in the particular claimed combination" is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

In *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person

possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). **It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious.** That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

Ex parte Hiyamazi, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988) (emphasis added).

The Applicant respectfully submits that the Office Action does not identify a proper motivation to combine the various references to reject the claims of the present application. Merely identifying isolated elements in the prior art is not enough to establish a prima facie case of obviousness, as shown below:

[M]ere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. [*In re Rouffet*, 149 F. 3d 1350] at 1355, 1357 [(Fed. Cir. 1998)]. Rather, to establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. *Id.* In practice, this **requires** that the Board “explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.” *Id.* at 1357-59. This entails consideration of both the “scope and content of the prior art” and “level of ordinary skill in the pertinent art” aspects of the Graham test.

**When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious.** *Id.* at 1358.

See *in re Kahn*, 441 F.3d 977 (Fed. Cir. March 22, 2006) (emphasis added).

As the MPEP dictates, the “teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” See Manual of Patent Examining Procedure (MPEP) at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). The Applicant respectfully submits, however, that the Office Action merely cites portions of the various references that may, but do not necessarily, disclose isolated claim limitations. The Office Action’s statements regarding motivation to combine the references amount to no more than conclusory statements of convenient assumptions about one of ordinary skill in the art, which is a factual question that cannot be resolved on “subjective belief and unknown authority.” See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). The Office Action does not explain the motivation, suggestion, or teaching to combine the various references. Again, mere identification of isolated elements is not enough to establish a prima facie case of obviousness. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements.” See *in re Kahn*, 441 F.3d 977 (emphasis added).

As the Federal Circuit has held, the “factual inquiry whether to combine references must be thorough and searching.” See, e.g., *McGinley v. Franklin Sports, Inc.* 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). “It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” See *In re Lee*, 277 F.3d at 1343 (internal citations omitted).

Federal Circuit “case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The “examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching reference.’” See *in re Lee*, 277 F. 3d at 1343, citing *In re Fitch*, 972 F. 2d 1260, 1265 (Fed. Cir. 1992) (emphasis added).

Merely citing portions of separate and distinct references that may or may not disclose an isolated claim element, however, is not a proper identification of a motivation to combine. The law requires that the Office Action show an objective teaching to support the assertions regarding motivation to combine the references.

In *In re Lee*, the Federal Circuit noted that the “Board rejected the need for ‘any specific hint or suggestion in a particular reference’ to support the combination of ... references,” which was an “[o]mission of a relevant factor required by precedent” that was both “legal error and arbitrary agency action.” See *id.* at 1344, citing *Morot Vehicle Manufacturers Ass’n v. State Farm Mutual Automobile Ins. Co.*, 463 U.S. 29 at 43 (1983) (emphasis added).

Subjective opinion of “common knowledge” or “common sense” regarding a motivation to combine is not enough to establish a *prima facie* case of obviousness. The Applicant respectfully submits that the motivation to combine the references identified in the Office Action is based on subjective knowledge and convenient assumptions gleaned from Applicant’s disclosure, instead of the prior art (as is required by the Federal Circuit). Thus, at least for these reasons, the Applicant respectfully submits that the claims should be in condition for allowance.

Notwithstanding the above, the Applicant responds to the rejections of the Office action as follows.

Claims 1-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Criss et al.* (US 2001/0029178 A1, hereinafter “Criss”) in view of *Angelo et al.* (US 5,974,250, hereinafter “Angelo”). The Applicant respectfully traverses the rejection.

The Applicant respectfully submits that the Examiner has failed to establish a case of *prima facie* obviousness for at least the reasons provided below. M.P.E.P. §2142 clearly states that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” The M.P.E.P. §2142 goes on to state that “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

With regard to claim 1, Applicant respectfully submits that the proposed combination of references fails to teach, suggest, or disclose, for example, "...[a] mobile services network comprising a mobile electronic device; a management server; an update package repository; and a generator with nodes preprocessor." More specifically, Applicant respectfully submits that Criss and Angelo, taken alone or in combination, fail to teach or suggest, at least, "...a generator with nodes preprocessor...", as recited in Applicant's claim 1.

The Office action alleges that "...Criss et al. discloses ...generator preprocessor (paragraph [0060]) and nodes (fig. 1, 5, 7; paragraph [0052], [0062], [0065]; Criss et al. teaches the update package either requested by user of mobile device or by the mobile device is able [to] determine what filenames it needs on the update package, hence, nodes)." (Office action at page 3) Applicant respectfully disagrees with what Criss allegedly teaches. In addition, Applicant respectfully points out that Applicant's claim 1 does not recite a "generator preprocessor and nodes" as stated in the Office action, but instead recites "a generator with nodes preprocessor".

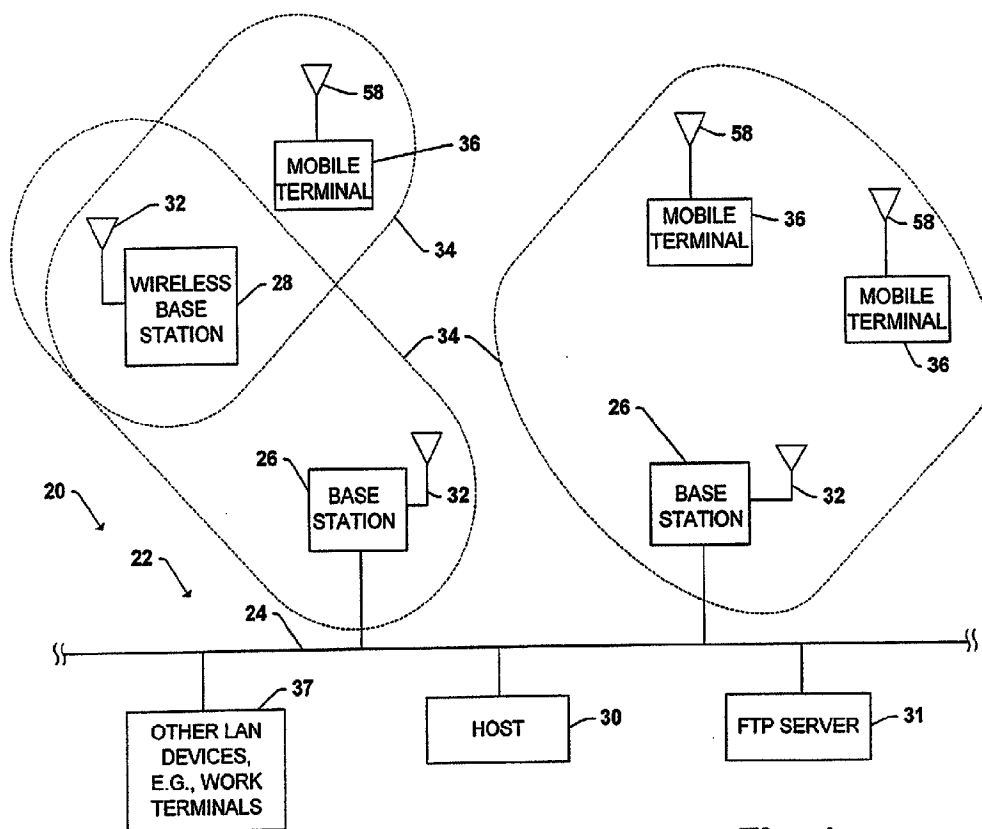
According to Criss at paragraph [0060]:

[0060] Referring now to FIG. 3b, a block diagram of the FTP server 31 is provided. Similar to the host computer 30, the FTP server 31 includes a processor 65 coupled to the system backbone 24 through a transceiver 71 and connector 73. A memory 67 is coupled to the processor 65. As will be described in more detail below, the memory 67 is updated with the latest version of software for each of the mobile terminals 36. For example, a system administrator may install revised versions of software in the memory 67.

Applicant respectfully submits that the above portion of Criss, which is specifically cited in the Office action as teaching Applicant's element "generator preprocessor", fails to teach anything with respect to a generator, or the generation of anything, or anything with respect to a preprocessor or preprocessing. The Office action has also failed to identify any other portion or figure of Criss that teaches or suggests Applicant's "generator". Therefore Applicant respectfully submits that the Office action has failed to identify the element(s) of the Criss reference that allegedly teach or suggest the "generator" element of Applicant's claim 1. Applicants also respectfully submit that the Office action has failed to identify anything in Angelo that teaches or suggests the "generator" element of Applicant's claim 1. Therefore, Applicant respectfully submits that the Office has failed to show where the proposed combination of Criss and Angelo teach "...a generator with nodes preprocessor...", as recited in Applicant's claim 1.

In addition, the Office action alleges that Criss discloses "...nodes (fig. 1, 5, 7; paragraph [0052], [0062], [0065]; Criss et al. teaches the update package either requested by user of mobile device or by the mobile device is able [to] determine what filenames it needs on the update package, hence, nodes)." (Office action at page 3) Applicant respectfully disagrees.

With regard to FIG. 1 of Criss, Applicant respectfully submits that according to Criss, at paragraph [0019], FIG. 1 "...is a block diagram of a wireless communication system in accordance with an exemplary embodiment of the present invention." A copy of FIG. 1 of Criss is shown below:



**Fig. 1**

Applicant respectfully submits that nothing in FIG. 1, or in the related text of Criss makes any mention of a “node” or of a “nodes preprocessor”. Therefore, Applicant respectfully submits that FIG. 1 fails to teach or suggest at least this aspect of Applicant’s claim 1.

With regard to FIG. 5 of Criss, Applicant respectfully submits that Criss does not contain a “FIG. 5”. Criss does, however, contain FIGs. 5a, 5b, 5c, and 5d, copies of which are shown below”:

Package Definition Files:

**Fig. 5a**

Package Name	Version ID, Req. Memory, Mode	File Name	Mobile Ter. Path	FTP Path	Type	ROM/RAM
--------------	-------------------------------	-----------	------------------	----------	------	---------

**Fig. 5b**

Package A	6.2, 200KB, replace	filename_A1	mpath A1	ftppath A1	...	ROM
		filename_A2	mpath A2	ftppath A2	...	RAM
		.	.	.	...	.
		filename_An	mpath An	ftppath An	...	ROM

**Fig. 5c**

Package B	A3, 150KB, fail safe	filename_B1	mpath B1	ftppath B1	...	RAM
		filename_B2	mpath B2	ftppath B2	...	RAM
		.	.	.	...	.
		filename_Bn	mpath Bn	ftppath Bn	...	ROM
...	...	...	...	...	...	...

**Fig. 5d**

Package Z	1.9, 320KB, replace	filename_Z1	mpath Z1	ftppath Z1	...	ROM
		filename_Z2	mpath Z2	ftppath Z2	...	ROM
		.	.	.	...	.
		filename_Zn	mpath Zn	ftppath Zn	...	RAM

Applicant respectfully submits that according to Criss, at paragraph [0024], FIG. 5a "...illustrates the general format of the package definition files stored in memory within the host computer, wherein each package definition file includes information identifying operating software to be used by mobile terminals within the system and information indicating the version of the operating software...." Criss also states, at paragraph [0025], that "...FIGS. 5b, 5c and 5d represent exemplary package definition files...."



Applicant respectfully submits that nothing in FIGs. 5a, 5b, 5c, or 5d, or in the related text of Criss makes any mention of a “node” or of a “nodes preprocessor”. Therefore, Applicant respectfully submits that FIGs. 5a, 5b, 5c, and 5d fail to teach or suggest at least this aspect of Applicant’s claim 1.

With regard to the teachings of paragraph [0052] of Criss, Applicant respectfully submits that paragraph [0052] states:

[0052] Accordingly, when a system operator wishes to change the operating software of one or more mobile terminals 36 within the system 20, the system operator loads the upgraded software into the FTP server 31 as discussed below. Included with each version of operating software is a unique identifier indicative of the particular version. The system administrator also updates the host computer to correspondingly reflect the modifications to the current software loaded in the FTP server. In particular, the system administrator updates the host computer with sufficient information to communicate those fields provided in the package definition files discussed below with respect to FIGS. 5a-5d. Then, when a mobile terminal 36 is next queried by the host computer regarding which version of operating software is being run, the mobile terminal 36 will be informed by the host computer 30 that the FTP server 31 has an upgraded version causing the mobile terminal 36 to request that the upgraded operating software be downloaded from the FTP server 31.

Applicant respectfully submits that the above portion of Criss, specifically cited in the Office action, fails to teach or suggest anything with respect to a “node” or of a “nodes preprocessor”. Therefore, Applicant respectfully submits that paragraph [0052] fails to teach or suggest at least this aspect of Applicant’s claim 1.

With regard to the teachings of paragraph [0062] of Criss, Applicant respectfully submits that paragraph [0062] states:

[0062] Also stored in the memory 66 is a collection of package definition files as represented in FIGS. 5a-5d. Specifically, the memory 66 includes a different package definition file for each particular package name included in

the boottab table shown in FIG. 4. FIG. 5a illustrates generally the various information fields included in each package definition file, whereas FIGS. 5b-5d provide illustrative examples of different package definition files. Each package definition file includes a version identifier (e.g., 6.2, A3, 1.9, etc.) which is a unique identifier of the particular version of the operating software associated with that particular package name. Each time one or more software files included in the operating software associated with a given package name is added, deleted or modified within the FTP server 31, the version identifier stored in the package definition file for that package name is modified to a new, unique identifier. The new identifier stored in the package definition files as discussed below is manually entered into the host computer 30 by a system administrator or the like, for example.

Applicant respectfully submits that the above portion of Criss, specifically cited in the Office action, also fails to teach or suggest anything with respect to a “node” or of a “nodes preprocessor”. Therefore, Applicant respectfully submits that paragraph [0062] fails to teach or suggest at least this aspect of Applicant’s claim 1.

With regard to the teachings of paragraph [0065] of Criss, Applicant respectfully submits that paragraph [0065] states:

[0065] Each time a system administrator updates any portion of the operating software stored in the memory 67, the system administrator also is responsible for assigning a new version identifier in the corresponding package definition file. For example, file names may be added or deleted from a package. Alternatively, one or more files may be modified. In either case, the operating software represents a new version. Once updated, the system administrator also updates the host computer 30 with sufficient information to produce for the mobile terminals 36 the package definition files discussed above with respect to FIGS. 5a-5d.

Applicant respectfully submits that the above portion of Criss, specifically cited in the Office action, fails to teach or suggest anything with respect to a “node” or of a

“nodes preprocessor”. Therefore, Applicant respectfully submits that paragraph [0065] fails to teach or suggest at least this aspect of Applicant’s claim 1.

Applicant respectfully submits that neither the cited portions of Criss, nor any other text or figure of Criss teaches or suggests anything with respect to a “node” or a “nodes preprocessor”, as recited in Applicant’s claim 1. Criss is simply silent with respect to the existence of a “node” or “nodes preprocessor”. Therefore Applicant respectfully submits that the Office action has failed to identify the element(s) of the Criss reference that allegedly teach or suggest the “node” or “nodes preprocessor” element of Applicant’s claim 1.

Applicants also respectfully submit that the Office action has failed to identify anything in Angelo that teaches or suggests a “node” or the “nodes preprocessor” element of Applicant’s claim 1. Therefore, Applicant respectfully submits that the Office has failed to show where the proposed combination of Criss and Angelo teach “...a generator with nodes preprocessor...” as recited in Applicant’s claim 1.

According to M.P.E.P. §707(a)(1):

On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

Applicant respectfully submits that even a cursory review of the specification would be sufficient for one of ordinary skill in the art to immediately recognize the nature of the subject matter, and that the terms “generator”, “nodes”, and “nodes preprocessor” recited in Applicant’s claims have no relationship to the cited portions of the Criss and Angelo references.

Based at least upon the above, the Applicant respectfully submits that the proposed combination of Criss and Angelo fails to teach or suggest each and every

limitation of Applicant's claim 1, that the Office has failed to establish a *prima facie* case of obviousness, and that a rejection of claim 1 under 35 U.S.C. §103(a) cannot be maintained.

With regard to claim 2, Applicant respectfully submits that the proposed combination of Criss and Angelo fails to teach or suggest, at least, "...wherein the generator with nodes preprocessor generates update packages by comparing an old version and a new version of firmware...." The Office action alleges that "...Criss et al. discloses wherein the generator with nodes preprocessor generates update packages by comparing an old version of firmware and a new version of firmware (Criss et al. teaches comparison according to predetermined criteria to updating being appropriate, paragraph [0016]-[0017], [0051], [0074])." (Office action at page 4) Applicant respectfully disagrees.

We first turn our attention to paragraphs [0016] and [0017], which state:

[0016] In accordance with another particular aspect of the invention, a wireless communication system is provided. The wireless communication system includes a system backbone, a host computer coupled to the system backbone, at least one base station coupled to the system backbone, the at least one base station including a base station transceiver for communicating wirelessly with mobile devices within the system, at least one mobile device having a mobile device transceiver for communicating wirelessly with the host computer on the system backbone via the at least one base station, and wherein the at least one mobile device includes a software update schedule table providing at least one time at which the at least one mobile device is to determine whether to selectively update mobile device operating software with at least one of the host computer and an FTP server coupled to the system backbone based on an initial comparison in accordance with a predetermined criteria indicative of whether updating of the mobile device operating software is appropriate.

[0017] In accordance with still another aspect of the invention, a mobile device is provided. The mobile device includes a processor, a memory coupled to the processor, a

transceiver for wirelessly transmitting and receiving information, and a software update schedule table stored in the memory, the software update schedule table providing at least one entry indicating a time at which the at least one mobile device is to determine whether to selectively update mobile device operating software with at least one of a host computer and an FTP server coupled to a system backbone based on an initial comparison in accordance with a predetermined criteria indicative of whether updating of the mobile device operating software is appropriate.

Applicant respectfully submits that nothing in the above portions of Criss, which were specifically cited by the Office, teaches or suggests, at least, "...wherein the generator with nodes preprocessor generates update packages by comparing an old version and a new version of firmware...." Criss makes no mention of comparing old and new versions of firmware. Indeed, no portion or figure of Criss makes any mention of firmware. Criss also fails to teach or suggest generating an update package. Instead, the cited portion of Criss shown above simply states that a wireless communication system has a system backbone, a host computer, and at least one mobile device that determines whether to selectively update mobile device operating software based on an initial comparison in accordance with a predetermined criteria indicative of whether updating of the mobile device operating software is appropriate. Nothing is said about comparing old and new versions of firmware, or of generating an update package. Applicant respectfully submits, therefore, that paragraphs [0016] and [0017] of Criss fail to teach or suggest, at least "...wherein the generator with nodes preprocessor generates update packages by comparing an old version and a new version of firmware...", as recited by Applicant's claim 2.

Next, we turn our attention to paragraph [0051], which states:

[0051] In the exemplary embodiment, the host computer 30 is responsible for supporting the network activities of the mobile terminals 36 within the system 20. As part of such function, the host computer 30 is responsible for determining whether the mobile terminals 36 have the most current versions of software and, if updating is needed, indicating to the mobile terminals 36 which operating

software needs to be updated. When a mobile terminal 36 within the system initially powers up (via an on/off switch for example) or is reset, the mobile terminal 36 goes through an initialization, or boot-up routine. Such routine includes communicating with the host computer 30 via a selected base station 26 in order that the host computer 30 provides the mobile terminal 36 with its internet protocol (IP) address as is conventional. In addition, however, just following the boot up routine, or at any time thereafter, the host computer 30 requests from the mobile terminal indicia which identifies which version of operating software the mobile terminal is running. The host computer 30 then compares the version of operating software stored within the mobile terminal 36 with the latest version of software known to be available in the FTP server 31. If the mobile terminal 36 has a different version of operating software stored as compared to the version currently available in the FTP server 31, it is assumed that the operating software in the FTP server 31 has been upgraded since the last time the mobile terminal 36 has logged on. Consequently, host computer 31 transmits a request to the mobile terminal 36 requesting the mobile terminal 36 to have its operating software updated. Upon receiving the request, the mobile terminal 36 initiates an exchange with the FTP server 31 to download the latest version of operating software available. In the event the version of the operating software stored in the FTP server 31 is the same version as that which is currently stored in the mobile terminal 36, the host computer 30 does not request the mobile terminal 36 to update its operating software. In this manner, needless downloading of files is avoided.

Applicant respectfully submits that nothing in the above portion of Criss, which was specifically cited by the Office, teaches or suggests, at least, "...wherein the generator with nodes preprocessor generates update packages by comparing an old version and a new version of firmware...." Criss makes no mention of comparing old and new versions of firmware. Indeed, no portion or figure of Criss makes any mention of firmware. Criss also fails to teach or suggest generating an update package. Instead, the cited portion of Criss shown above simply states that a host computer requests from the mobile terminal indicia which identifies which version of operating software the mobile terminal is running, and then compares the received indicia with the

indicia for latest version of software known to be available in a server. If the comparison of the indicia indicates that the mobile terminal has a different version of operating software than that available in the server, the host computer transmits a request to the mobile terminal to have its operating software updated. The mobile terminal then initiates an exchange with the server to download the latest version of operating software available. Criss says nothing about comparing old and new versions of firmware, or of generating an update package. Applicant respectfully submits that paragraph [0051] of Criss fails to teach or suggest, at least, "...wherein the generator with nodes preprocessor generates update packages by comparing an old version and a new version of firmware...", as recited by Applicant's claim 2.

Finally, we turn our attention to paragraph [0074], which states:

[0074] Following receipt of the Version Response Packet 124, the host computer 30 performs a comparison between the version indicator stored in the version indicator field 127 and the version of the corresponding operating software stored in the FTP server 31. Once the host computer 30 completes its comparison, the host computer 30 transmits a File Name Packet 128 to the mobile terminal 36 as shown in FIG. 7(e). The File Name Packet 128 includes a header 129, and a comparison result field 133. In the event the comparison performed by the host computer 30 showed that the version of operating software stored in the mobile terminal 36 is the same as the latest version of corresponding operating software stored at the FTP server 31, the host computer 30 includes indicia in the comparison result field 133 indicating that no update is needed. In the present embodiment, when the versions are identical, the host computer 30 includes the version of the operating software in the comparison result field 133. Thus, upon receipt of the File Name Packet 128, the mobile terminal 36 is able to discern that no additional downloading of operating software is necessary.

Applicant respectfully submits that nothing in the above portion of Criss, which was specifically cited by the Office, teaches or suggests, at least, "...wherein the generator with nodes preprocessor generates update packages by comparing an old

version and a new version of firmware....” Paragraph [0074] of Criss makes no mention of comparing old and new versions of firmware. Indeed, no portion or figure of Criss makes any mention of firmware. Criss also fails to teach or suggest generating an update package. Instead, the cited portion of Criss shown above simply states that a host computer compares a version indicator stored in a version indicator field of a version response packet received from a mobile terminal and indicia that represents the version of corresponding operating software stored in a server. The host computer then transmits a file name packet to the mobile terminal. The file name packet includes a header and a comparison result field. If the comparison showed that the version of operating software stored in the mobile terminal is the same as the latest version of corresponding operating software stored at the server, the host computer includes indicia in the comparison result field indicating that no update is needed. Criss, however, says nothing about comparing old and new versions of firmware, or of generating an update package. Applicant respectfully submits, therefore, that paragraph [0074] of Criss fails to teach or suggest, at least, “...wherein the generator with nodes preprocessor generates update packages by comparing an old version and a new version of firmware...”, as recited by Applicant’s claim 2.

In addition, Applicant respectfully submits that Angelo also fails to teach or suggest, at least, comparing old and new versions of firmware, and the generation of an update package. Applicant respectfully submits that the Office has failed to set forth any teaching or suggest from Angelo in this regard. Therefore, Applicants respectfully submit that, necessarily, the proposed combination of Criss and Angelo fails to teach or suggest “...wherein the generator with nodes preprocessor generates update packages by comparing an old version and a new version of firmware...”, and therefore fails to teach or suggest all of the limitations of Applicant’s claim 2.

Therefore, Applicant believes that claim 1 is allowable over the proposed combination of Criss and Angelo, for at least the reasons set forth above. Applicants respectfully submit that claims 2-15 depend either directly or indirectly from claim 1. Because claims 2-15 depend from allowable claim 1, Applicant respectfully submits that claims 2-15 are also allowable, for at least the same reasons. Applicant respectfully



submits, therefore, that the rejection of claims 1-15 under 35 U.S.C. §103(a) be withdrawn.

Claims 13-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Criss in view of Angelo, and further in view of Hayes, Jr. et al. (US 5,974,312, hereinafter "Hayes"). The Applicant respectfully traverses the rejection.

With regard to claim 16, the Applicant respectfully submits that the proposed combination of references fails to teach, suggest, or disclose "...[a] method for generating an update package using an old image and a new image of a firmware in a mobile services network, the method comprising converting symbols in the new and old images of the firmware into distance information; determining a list of nodes in the old and new images of the firmware; generating filter information; generating the update package; and outputting the generated update package."

The Office action states "...the combination of Criss et al. and Angelo et al. discloses a method for generating an update package using an old image and a new image of firmware in a mobile services network, the method comprising:...." (Office action at page 7) Applicant respectfully disagrees. Applicant respectfully submits that the proposed combination of Criss and Angelo fails to teach or suggest, at least, "...a method for generating an update package using an old image and a new image of firmware...", for at least the reasons set forth above with respect to claim 2. Applicant also respectfully submits that the Office action has failed to identify where Hayes sets forth any teaching or suggestion with respect to "...a method for generating an update package using an old image and a new image of firmware...." Therefore, Applicant respectfully submits that the proposed combination of references fails to teach or suggest, at least, this aspect of Applicant's claim 16.

Applicant appreciates recognition by the Office that "...Criss [and Angelo] do not specifically disclose [sic] converting symbols in the new and old images of the firmware into distance information); determining a list of nodes in the old and new images of the firmware...." The Office action, attempts to overcome the failure of Criss and Angelo to

teach "...converting symbols in the new and old images of the firmware into distance information ...", by relying on Hayes, at column 10, lines 35-40, which states:

Multiple data frames may be transmitted on any one Data Channel 465. This permits the update of multiple subblocks in a given reprogramming operation. For example if a given reprogramming operation includes updating five memory subblocks in a particular class of devices 100, the Data Channel 465 will carry five data frames D1-D5.

The Office action makes the conclusory statement that the above portion of Hayes "...teaches the ability to update sub-blocks of data, hence the ability to determine distance information...." (Office action at page 7) Applicant respectfully disagrees. Applicant respectfully submits that the portion of Hayes shown above, which was specifically cited by the Office, fails to teach or suggest "...converting symbols in the new and old images of the firmware into distance information...", as recited in Applicant's claim 16. The Office action fails to provide any reasoned explanation regarding how this portion of Hayes allegedly teaches the ability to determine distance information, let alone any explanation of how such a teaching applies to "...converting symbols in the new and old images of the firmware into distance information...." Therefore, Applicant respectfully submits that the Hayes fails to remedy the admitted shortcoming of Criss and Angelo, and that the proposed combination of references fails to teach or suggest at least this aspect of Applicant's claim 16.

The Office attempts to overcome the failure of Criss and Angelo to teach "...determining a list of nodes in the old and new images of the firmware..." by relying on Hayes, and makes the conclusory statement that "...Hayes et al. teaches [the] limitation (wireless manager, abstract, col. 15, lines: 4-9, has lists of blocks needed to be updated)." (Office action at page 7) Applicant respectfully disagrees. Applicant respectfully submits that the Office fails to provide any reasoned explanation as to why the cited portion of Hayes teaches "...determining a list of nodes in the old and new images of the firmware..." other than "...has lists of blocks needed to be updated...".

Applicant respectfully submits that the failure of the Office action to explain how the Examiner came to such a conclusion does not meet the mandates of M.P.E.P. §2142.

In addition to the reasons set forth above, the Applicant respectfully submits that the Office has failed to address all of the limitations of claim 16. For example, the Office action fails to address Applicant's feature "...generating filter information;...", "...generating the update package;...", and "...outputting the generated update package...", as recited in Applicant's claim 16. The Office action makes no attempt to identify any teaching in any of the references regarding these limitations. Therefore, the Applicant respectfully submits that the Office has failed to show where the proposed combination of references teaches or suggests these limitations.

Based at least upon the above, Applicant respectfully submits that the Office action has failed to show where the proposed combination of Criss, Angelo, and Hayes teaches each and every limitation of claim 16, as required by M.P.E.P. §2142, that the Office has failed to establish a *prima facie* case of obviousness, and that a rejection of claim 16 under 35 U.S.C. §103(a) cannot stand.

Therefore, Applicant believes that claim 16 is allowable over the proposed combination of Criss, Angelo, and Hayes, for at least the reasons set forth above. Applicants respectfully submit that claims 17-21 depend, either directly or indirectly, from claim 16. Because claims 17-21 depend from allowable claim 16, Applicant respectfully submits that claims 17-21 are also allowable, for at least the same reasons. Applicants respectfully request, therefore, that the rejection under 35 U.S.C. §103(a) of claims 16-21 be withdrawn.

With regard to claims 13-15, Applicant respectfully submits that claims 13-15 depend from independent claim 1. Applicant believes that claim 1 is allowable over the proposed combination of references, in that Hayes fails to overcome the deficiencies of Criss and Angelo, as set forth above with respect to claim 1. Because claims 13-15 depend from allowable claim 1, Applicant respectfully submits that claims 13-15 are also allowable, for at least the same reasons. Therefore, Applicant respectfully requests that the rejection of claims 13-15 under 35 U.S.C. §103(a) be withdrawn.

With regard to claim 22, Applicant respectfully submits that claim 22 is allowable for at least the reasons set forth above with respect to claims 1-21. In addition, Applicant respectfully submits that the Office action has failed to address all of the limitations of claim 22, and has therefore failed to show that the proposed combination of references teaches or suggests each and every limitation of Applicant's claim 22, as required by M.P.E.P. §2142.

Therefore, Applicant believes that claim 22 is allowable over Criss, Angelo and Hayes, for at least the reasons set forth above, and respectfully requests that the rejection of claim 22 under 35 U.S.C. §103(a) be withdrawn.

### **Conclusion**

In general, the Office action makes various statements regarding claims 1-22 and the cited reference that are now moot in light of the above. Thus, Applicant will not address such statements at the present time. However, Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicant believes that all of pending claims 1-22 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicant invites the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Dated: October 12, 2007

Hewlett-Packard Company  
Intellectual Property Administration  
Legal Department, M/S 35  
P.O. Box 272400  
Fort Collins, CO 80527-2400

/Kevin E. Borg/  
Kevin E. Borg  
Reg. No. 51,486